

### **REMARKS**

Claims 2, 4, 36-51 and 63-74 are pending in this application and stand rejected. Claims 36, 43, 44, 51, 63, 64, 74, 97, 100, 103, 106, and 109 have been revised. Claims 36, 43, 51, 63 and 74 are remain independent.

Various claims have been amended to avoid use of the term signal, since the Advisory Action mailed on July 31, 2008, stated that this term would be considered non-statutory subject matter. In addition, Applicant does not concede that the use of signal in the claims would have rendered them non-statutory. This issue is addressed in M.P.E.P. § 2106(IV)(B), which cited In re Nuijten, Docket No. 2006-1371 (Fed. Cir. Sept. 20, 2007)(slip op. at 18). That case only holds that a claim drawn only to a signal is non-statutory. Nuijten recognizes that the term "signal" can be used in a claim without making the claim non-statutory under 35 U.S.C. § 101. Nuijten specifically noted that the applicant had obtained allowance of a process claim, not at issue in the appeal, covering "A method of embedding supplemental data in a signal, comprising the steps of: encoding the signal..." Nuijten therefore only provides that a "pure" signal claim, drawn to a signal itself, is non-statutory.

The following patentability remarks generally track those set out in Applicant's July 3 Amendment After Final Rejection. They have been modified to conform to the revised claims.

#### **The Rejection Under 35 U.S.C. § 102**

Claims 36-41, 43-48, 50, 51, 63-68, 70 and 74 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent no. 5,899,980 to Wilf et al. Applicant respectfully traverses this rejection, and submits the following arguments in support thereof.

Claim 36 describes an electronic system for setting up an authentication through a communication network having a personal terminal which is operated for participating in the authentication, the personal terminal being connectable to the communication network and including an information indicating unit and an input unit for inputting an indication, a virtual terminal which is connectable to the communication network for participating in the authentication with the personal terminal, and a synchronizing server communicating with the personal terminal and the virtual terminal, the synchronizing server activating the virtual terminal and setting up link information including authentication ID information in association with the virtual terminal and transmitting the link information to the personal terminal upon receipt by the synchronizing server of information regarding the authentication, and the synchronizing server establishing a synchronization of communication between the personal terminal and the virtual terminal one-to-one upon receipt of both the same authentication ID information and the indication in response to the link information indicated on the indicating unit from the personal terminal. The personal and virtual terminals send and receive messages in real time via the synchronizing server during synchronization, and the synchronizing server initiates the virtual terminal after the communication.

Claim 43 involves an electronic server system for setting up an authentication through a communication network, which communicates a virtual terminal for participating in the authentication with a personal terminal including an information indicating unit and an input unit for inputting an indication. The electronic server system has a communicating section connected to the communication network and a processing unit for communicating with the personal terminal and with the virtual terminal through the communicating section, the

processing unit activating the virtual terminal and setting up link information including authentication ID information in association with the virtual terminal and transmitting the link information which is indicatable in the information indicating unit of the personal terminal upon receipt of information regarding the authentication, the processing unit establishing synchronization of communication between the personal terminal and the virtual terminal one-to-one upon receipt of both the same authentication ID information transmitted to the personal terminal and the indication in response to the link information indicated on the indicating unit from the personal terminal. The personal and virtual terminals send and receive messages in real time via the processing unit server during synchronization, and the processing unit initiates the virtual terminal after the communication.

Claim 51 is drawn to a recording medium which stores a program for a computer, for setting up an authentication through a communication network, which communicates a virtual terminal for participating in the authentication with a personal terminal including an information indicating unit and an input unit for inputting an indication. The medium has a communicating module which operates the computer to communicate with the virtual terminal and with the personal terminal through the communicating network, and a processing module for communicating with the personal terminal and with the virtual terminal through the communicating section, the processing module activating the virtual terminal and setting up link information including authentication ID information in association with the virtual terminal and transmitting the link information which is indicatable in the information indicating unit of the personal terminal upon receipt of information regarding the authentication transmitted by the personal terminal, the processing module establishing synchronization of communication

between the personal terminal and the virtual terminal one-to-one upon receipt of both the same authentication ID information transmitted to the personal terminal and the indication in response to the link information indicated on the indicating unit from the personal terminal. The processing module controls sending and receiving of messages in real time by the personal and virtual terminals during the synchronization, and initiates the virtual terminal after the communication.

Claim 63 concerns an electronic server system for setting up an authentication through a communication network, which communicates with a virtual terminal for participating in the authentication, a personal terminal having an information indicating unit, and an order-receiving center including an order-receiving unit for receiving the information regarding the authentication through an input unit of a communicating terminal for inputting information regarding the authentication. The electronic server system has a communicating section connected to the communication network, and a processing unit for activating the virtual terminal and setting up a link information including authentication ID information in every authentication and transmitting the link information which is indicatable in the information indicating unit of the personal terminal, upon receipt of the information regarding the authentication transmitted by the order-receiving unit through the communicating section, the processing unit establishing a synchronization of communication between the personal terminal and the virtual terminal one-to-one upon receipt of both the same authentication ID information transmitted to the personal terminal and an indication inputted by using the input unit in response to the link information indicated on the indicating unit from the personal terminal. The personal

and virtual terminals send and receive messages in real time via the processing unit server during the synchronization and the processing unit initiates the virtual terminal after the communication.

Claim 74 is drawn to a recording medium which stores a program for a computer, for setting up an authentication through a communication network, which communicates with a virtual terminal for participating in the authentication, a personal terminal having an information indicating unit, and an order-receiving center including an order-receiving unit for receiving the information regarding the authentication through an input unit of a communicating terminal for inputting information regarding the authentication. The recording medium has a communicating module which operates the computer to communicate with the virtual terminal and with the personal terminal through the communicating network, and a processing module for activating the virtual terminal and setting up a link information including authentication ID information in every authentication and transmitting the link information which is indicatable in the information indicating unit of the personal terminal upon receipt of the information regarding the authentication transmitted by the order-receiving unit through the communicating section, the processing module establishing a synchronization of communication between the personal terminal and the virtual terminal one-to-one upon receipt of both the same authentication ID information transmitted to the personal terminal and an indication inputted by using the input unit in response to the link information indicated on the indicating unit from the personal terminal. The processing module controls sending and receiving of real time messages by the personal and virtual terminals during the synchronization and initiating the virtual terminal after the communication.

Applicant respectfully submits that Wilf does not suggest the claimed invention, for example, insofar as the claims provide for the exchange of messages between the personal and virtual terminals in real time. As explained above, this feature of "real time" exchange appears in each of the independent claims.

Applicant contends that Wilf's ISP 31 and the consumer computer 51 do not communicate with each other via STSP 20 in real time.

Furthermore, neither the claim feature providing that the synchronizing server activates the virtual terminal, nor the claim feature providing that the synchronizing server initiates the virtual terminal after the communication, which features enhance security, are taught or suggested by Wilf.

Accordingly, this rejection is not well-taken, because Wilf fails to identically disclose all of the features of the claimed invention. A reference which does not identically disclose all the features of a claimed invention cannot anticipate that invention. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565 (Fed. Cir. 1986). See also In re Paulsen, 30 F.3d 1475 (Fed. Cir. 1994); Constant v. Advanced Micro-Devices Inc., 848 F.2d 1560 (Fed. Cir. 1988); M.P.E.P. § 2131 ("To anticipate a claim, the reference must teach every element of the claim").

In addition, for there to be an anticipation under § 102, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the art in the field of the invention. Scripps Clinic & Res. Found. v. Genentech Inc., 927 F.2d 1565 (Fed. Cir. 1991). As demonstrated above, Wilf is drawn to a different configuration and would not suggest the present invention.

The remaining rejected claims, claims 37-41, 44-48, 50, 64-68 and 70, all ultimately depend from and so incorporate by reference all the features of the independent claims just shown to distinguish over Wilf. These dependent claims therefore patentably distinguish over Wilf for at least the same reasons as their respective base claims.

For all the foregoing reasons, favorable reconsideration and withdrawal of this rejection are respectfully requested.

**The Rejections Under  
35 U.S.C. § 103(a)**

Claims 42, 49, 69, 71 and 73 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilf in view of the PR Newswire article entitled "Geoworks First to Deliver Shopping Discounts Direct to Mobile Phones and Pages" (referred to by the Office Action as "PRN"), hereafter "PRN". Applicant respectfully traverses this rejection and submits the following arguments in support thereof.

Initially, this rejection is traversed as failing to establish a *prima facie* case of obviousness in the manner required by the Supreme Court and the M.P.E.P. The Office Action fails to make all the factual findings which are required to support an obviousness rejection under 35 U.S.C. § 103(a), in particular, a finding of fact regarding the level of ordinary skill in the art at the time of invention. Such a finding is one of the three different factual findings that the Patent and Trademark Office requires for an obviousness rejection under 35 U.S.C. § 103(a). The Patent and Trademark Office's Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc., 72 Fed. Reg. 57526, 57527 (October 10, 2007) (hereafter "KSR Guidelines"), incorporated into M.P.E.P. § 2141 (8th ed., rev. 6), states:

[a]s reiterated by the Supreme Court in KSR, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in Graham v. John Deere Co. (citation omitted) Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.**

(emphasis added). This portion of the KSR Guidelines is reflected in M.P.E.P. § 2141(II) (8th ed., rev. 6).

The Office Action fails to comply with the KSR Guidelines, since no finding was made regarding the level of ordinary skill in the art at the time this invention was made.

Applicant respectfully submits that such a finding is particularly important here to prevent the improper use of hindsight in assessing whether the prior art suggests the claimed invention because the Office Action, admitting Wilf's deficiencies at page 8, point 2, contends one of ordinary skill in the art would modify Wilf in accordance with the teachings of PRN.

Furthermore, the Office Action justifies this modification by alleging "a person of ordinary skill has good reason to pursue known options within his or her technical grasp". Having asserted that substantial modifications to Wilf would be obvious to a person having ordinary skill in the art, it is incumbent upon the Office Action to provide sufficient factual findings to support such an assertion and to establish the qualifications of the person having ordinary skill in the art. That was not done here, meaning the Office Action fails to comply with the KSR Guidelines.

Still another reason why a factual finding as to the level of ordinary skill in the art is needed is due to the substantial time that has passed since this invention was made -- this



application has an effective filing date of August 2, 1999. Owing to the passage of time, some nine years from that effective date, there is a substantial risk of improperly relying on hindsight when evaluating the prior art in the absence of a clear finding regarding the level of ordinary skill in the art at the time of invention.

The KSR Guidelines state "[i]n certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done" id. at 57527. This is reflected in M.P.E.P. § 2141(II) (8th ed., rev. 6). It is respectfully submitted that this application presents precisely the type of situation where the KSR Guidelines and the M.P.E.P. encourage the setting forth of thorough factual findings regarding the level of ordinary skill in the art.

It is further submitted that, in the event factual findings are made as to the level of ordinary skill in the art, the determined level of ordinary skill in the art will not be sufficiently high to justify the Office Action's reasoning in contending that a person having ordinary skill in the art would modify Wilf in view of PRN to arrive at the claimed invention.

For all the foregoing reasons, Applicant respectfully submits that the Office Action has failed to establish a *prima facie* case of obviousness, and so this rejection must be withdrawn.

Even if the level of ordinary skill in the art is established, the claimed invention still patentably distinguishes over the combination of Wilf and PRN in view of the following points.

The rejected claims depend from and so incorporate by reference all the features of claims 36, 43 and 63, including those features which already have been shown to patentably distinguish over Wilf, including features providing for the real-time sending and receiving of messages by the personal and virtual terminals.

PRN only involves the use of promotional codes in lieu of paper coupons, and there is no discussion of real-time communication in PRN, much less real-time communication as claimed. Consequently, PRN fails to remedy Wilf's deficiencies regard the real-time sending and receiving of messages by the personal and virtual terminals. accordingly, the rejected claims patentably distinguish over the combination of Wilf and PRN for the same reasons, discussed above, that the independent claims patentably distinguish over Wilf alone.

Accordingly, favorable reconsideration and withdrawal of this rejection are respectfully requested.

#### **REQUEST FOR INTERVIEW**

Applicant respectfully requests that, in the event the foregoing claim changes and patentability arguments are not deemed to be persuasive, Applicant's undersigned attorney be permitted to conduct a telephonic interview to explain why the claimed invention patentably distinguishes over the cited art.

#### **CONCLUSION**

Applicant respectfully submits that all outstanding rejections have been addressed and are now overcome or are moot, and the claim pending is patentable over the prior art. Favorable reconsideration and allowance are respectfully requested.

Other than the fees for the accompanying Request for Continued Examination and Petition for Extension of Time respectively authorized therein, no fees are believed to be due in connection with the filing of this Amendment. Nevertheless, should the Commissioner deem any additional fee(s) to be now or hereafter due, the Commissioner is authorized to charge all such fees to Deposit Account No. 19-4709.

In the event that there are any questions, or should additional information be required, please contact Applicant's attorney at the number listed below.

Respectfully submitted,

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